

The opinion in support of the decision being entered today was not written  
for publication and is not binding precedent of the Board.

Paper No. 17

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte JOSEPH C. ASTA

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Appeal No. 2003-0017  
Application No. 09/326,996

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ON BRIEF

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Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 2 to 11, 13 to  
15, 21 and 22, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a golfing aid (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Pruitt	2,979,335	Apr. 11, 1961
Piazza	4,021,068	May 3, 1977
Luther, Sr.	5,335,953	Aug. 9, 1994
Erickson, Jr.	5,759,117	June 2, 1998
Cole et al. (Cole)	6,290,617	Sep. 18, 2001

Claims 3 to 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Piazza in view of Cole.

Claims 2, 7, 11, 21 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Piazza in view of Erickson.

Claims 8 to 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Piazza in view of Erickson and Pruitt.

Claims 13 to 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Piazza in view of Luther.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 13, mailed June 4, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 8, filed May 2, 2001), supplemental brief (Paper No. 12, filed March 26, 2002) and reply brief (Paper No. 14, filed August 13, 2002) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 2 to 11, 13 to 15, 21 and 22 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

#### **The claimed subject matter**

Claims 4, 7 and 13, the independent claims under appeal, read as follows:

4. A golfing aid comprising:  
an elongated member having a first end and a second end, said first end being provided with golf ball holding means, and said elongated member further being provided with means for releasing a golf ball from said holding means and means for retaining a divot repair tool; and  
a divot repair tool held by said retaining means, said repair tool including an elongated shaft having opposite ends and a divot repair element at one of said ends of said shaft.
7. A golfing aid comprising:  
an elongated member having a first end and a second end, said first end being provided with golf ball holding means, and said elongated member further being provided with means for releasing a golf ball from said holding means, at least one of said elongated member, said holding means and said releasing means having a first golf ball marker holding portion for storing a golf ball marker, and at least one of said elongated member, said holding means and said releasing means having a second golf ball marker holding portion for depositing a golf ball marker on and retrieving a golf ball marker from the ground.

13. A golfing aid comprising:  
an elongated member having a first end and a second end, said first end being provided with golf ball holding means, and said elongated member further being provided with means for releasing a golf ball from said holding means; and  
support means for said elongated member, said support means being pivotally mounted on said elongated member.

### **Teachings of the applied prior art**

#### *Piazza*

Piazza's invention relates to a device for retrieving golf balls. The device comprises a tapered receptacle to which a hand operated vacuum pump is attached. The receptacle is sized so that a golf ball entering its lower end will be lightly trapped against its flexible sides. The vacuum pump is part of the retriever handle and is preferably of the piston and cylinder type. When the retriever is used for a ball lying on a soft surface, the receptacle is moved over the ball and in close proximity to it. A movement of the vacuum pump piston creates a flow of air or water as the case may be towards and around the ball. The force of the flow pushes the ball into the receptacle where it is trapped. The retriever can now be withdrawn from the water hazard or rough. A reverse motion of the piston then frees the ball. When used with balls lying on hard terrain, the device is lowered over the ball and pushed in a direction away from the user. This forces the ball into the receptacle and no use is made in this case of the vacuum pump.

Referring now in detail to Figures 1 and 2 it will be seen that the device is comprised of a tapered receptacle 1 firmly and communicably joined to a tubular handle 2. The receptacle is preferably in the form of a truncated cone and made of relatively thin material so that its walls are somewhat flexible. A ball 9 entering the receptacle 1 flexes the walls slightly and is locked inside the receptacle by friction. Plastic has been found suitable as a material of construction for the receptacle but other materials such as aluminum can be used. The inner surface 16 of the receptacle 1 is roughened to aid in frictional retention of the ball. The piston 4 is comprised of three sections of differing lengths and diameters. The relatively long upper section 4a is of a diameter somewhat less than the inside of tubular handle 2. The relatively short center section 4b is of a diameter to give a close fit with the inside of the tubular handle 2 and contains an annular groove 17 and an "O" ring 5. The center section by its construction acts as a moving seal and is used to create a partial vacuum in receptacle 1. The lower section 4c of the piston is relatively long and of the smallest diameter. The lower section of the piston serves several purposes. During a retrieval from a hard surface the lower section is contacted by the ball and is moved upwards to the position 7 shown in Figure 2. An operating knob 6 joined to the upper section of the piston moves and signals the user that the ball has entered the receptacle. Downward pressure on knob 6 now frees the ball.

When the invention is employed to retrieve a ball from water as is shown in Figure 1, the operation is somewhat different. The receptacle 1 is moved within a short distance of the ball. The operating knob 6 is now pulled back with one hand while the handle 2 is held with the other. The partial vacuum thus created in receptacle 1 induces a rapid flow of water towards its opening. The ball 9 is thereby forced into receptacle 1 and is frictionally retained. The seal between the ball 9 and the walls of the receptacle is not completely tight because of the roughened surface 16 and the dimples in the surface of the ball so that the vacuum is soon relieved after the ball is in place. The frictional retention of the ball against surface 16 is however not altered by the relief of the partial vacuum. Whenever the user desires to release the ball, he presses the operating knob 6 downward. The sealing section 4b of the piston 4 acting against the air in the inside of handle 2 now functions as a pressure pump and forces the ball to drop out of the receptacle 1.

#### *Cole*

Cole's invention relates to a golf club accessory device. As shown in Figures 1-8, the device is an essentially flat plastic member having a forked end for use in replacing divots or green repair, and integral jaw members for attachment of the device to the club shaft adjacent the head so that when the club is stored in a golf bag the device can be readably removed. The end of the device opposite the forked portion

provides a cradle, and a removable ball marker is carried by the device. The ball marker typically has a spindle that is pressed fitted through a hole in the device so that it can be physically separated to be used by the golfer.

*Erickson*

Erickson's invention relates to a golf ball teeing device which allows an impaired or elderly golfer to tee a golf ball without the need of bending over. The device may also be used to retrieve balls from the ground, cup or water hazards. As shown in Figures 1-6, these goals are accomplished by the use of a long handled, golf club-like device with a spring loaded golf ball and tee holding device at its bottom end and a depressable knob at the top end. The golfer uses the device by depressing the knob, which opens the gap between the ball holder and tee holder, thereby allowing a golfer to place a tee and golf ball in the device. The user then places the device in an upright position and pushes the tee at the bottom end of the device into the ground, and again depresses the knob, releasing the tee and the ball in their desired position. The golfer may also depress the knob, causing the aforementioned gap to open, and allowing the golfer to place the gap over a golf ball that is on the ground. When the golfer releases the knob, the gap closes, securing the golf ball within the holding device. In this way, the golfer can use the device to pick up balls from the ground, cup and to retrieve balls from a water hazard.



As shown in Figures 2 and 3, the release knob 18 has attached to it a magnet 26, to which a ball marker 24 attaches. As shown in Figures 2 and 7-9, an attachable greens keeper is attachable to the golf ball teeing device by snapping it to the exposed part of an inner shaft just below the ball holder and above the tee holder. The accessory is made up of a greens keeper 32 which is attached to a greens keeper holder 34 which on its inner surface has a snap groove 44 which fits over the inner shaft. This allows the golfer to repair ball marks left on the green without the need to bend over by attaching the greens keeper to the lower portion of the golf ball teeing device.

*Pruitt*

Pruitt's invention relates to a golf club having a permanent magnet used for removably carrying a magnetic keeper which, when removed, is utilized as a marker for indicating the previous position of a golf ball which had been lifted from the putting green. As shown in Figures 1-7, the upper extreme end of the handle of the golf club is provided with an open top recess 26. A permanent magnet 36 is disposed within the recess with the upper side thereof below the top of the handle. A marker 42 of magnetic material is disposed within the recess and above the magnet and is removably held in place by the magnet. The walls of the recess completely surround

the marker when held in position by the magnet, and preferably, the top side of the marker is slightly below the top of the putter.

Since the marker 42 is wider than the upper surface 44 of the magnet 36, it can be readily tilted by pressing on the outer surface thereof near the periphery thereof. When such pressure is applied, the outer edge of the magnet functions as a fulcrum for the marker. By pressing near the outer edge of the marker with a finger or thumb, the other fingers of the same hand of the player can be used to detach the marker from the magnet, since at that time, the part of the marker which is diagonally opposite the point of pressure on the marker, is raised a sufficient distance above the cover so that it is readily accessible for handling, as shown in Figure 1. As shown in Figure 6, the construction is such that the club can be used for lifting the marker off the green. Thus eliminating a stooping movement of the player. Once the marker is attracted to the magnet, it can, if not properly seated in the recess, be readily seated by a sliding movement imparted thereto by a finger.

#### *Luther*

Luther's invention relates to a golf ball retrieving and dispensing apparatus which includes an elongated inner tube and an elongated outer tube mounted telescopically slidable with respect to each other such that a single longitudinal axis is

common to both tubes, the tubes being substantially coextensive and having upper and lower ends. The outer tube has two legs releasably attached thereto adjacent its lower end and adapted to hold said apparatus in a general vertical free-standing position when resting on a horizontal surface. The outer tube at its bottom end includes an expandable contractable means to expand sufficiently to encircle a golf ball and then contract sufficiently to grip the golf ball and hold it against the bottom end of the inner tube when the bottom end of the inner tube is retracted to the bottom end of the outer tube and then to expand again and release the golf ball when the bottom end of the inner tube is protracted outwardly from the bottom end of the outer tube.

As shown in Figure 1, two legs 24 made of heavy wire are provided which together with lower end 23 of inner tube 21 (with golf ball 26 gripped by fingers 25) form a tripod to allow the apparatus to stand in generally vertical position, tipped to an angle of about 10°-20° from the vertical. The legs 24 are locked securely at the desired angle which provides stability for the apparatus. Luther teaches (column 4, line 67, to column 3, line 2) that "[i]t is, of course, entirely within the scope of this invention to employ other types of legs, whether permanently attached or detachably connected."

### **Claims 3 to 6**

We will not sustain the rejection of claims 3 to 6 under 35 U.S.C. § 103 as being unpatentable over Piazza in view of Cole.

We agree with the examiner's determination (answer, pp. 3-4) that it would have been obvious to one of ordinary skill in the art to provide the tool of Piazza with the tool of Cole in order to allow the user to repair divots in the golf green.<sup>1</sup> However, we find ourselves in agreement with the appellant that this combination of tools does not arrive at the subject matter of claim 4. Specifically, the claimed elongated member being further provided with means for retaining a divot repair tool is not met by this combination of tools. As correctly pointed out by the examiner (answer, p. 6), this "means plus function" corresponds to the structure set forth on page 10, lines 17-22 of the instant specification. Thus, the structure corresponding to the means for retaining a divot repair tool is both the magnetic or magnetizable button 54 on the elongated member 12 and the clamp 48 on the elongated member 12. However, the elongated member of Piazza's tool (i.e., handle 2) does not contain either a magnetic or magnetizable button or a clamp, or for that matter, any structure that could be considered to be equivalent to both a magnetic or magnetizable button and a clamp. Accordingly, it is our view that the tool of Piazza when mounted with the tool of Cole

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<sup>1</sup> Erickson teaches a divot repair tool retained on a golf ball holding tool.

does not have an elongated member provided with means for retaining a divot repair tool as set forth in claim 4 on appeal.

For the reasons set forth above, the decision of the examiner to reject claim 4, and claims 3, 5 and 6 dependent thereon, under 35 U.S.C. § 103 is reversed.

**Claims 2, 7, 11, 21 and 22**

We will not sustain the rejection of claims 2, 7, 11, 21 and 22 under 35 U.S.C. § 103 as being unpatentable over Piazza in view of Erickson.

We agree with the examiner's determination (answer, p. 4) that it would have been obvious to one of ordinary skill in the art to modify the handle of Piazza's tool to hold a golf ball marker as suggested and taught by Erickson. However, once again we find ourselves in agreement with the appellant that this modification of Piazza does not arrive at the claimed subject matter. Specifically, we agree with the appellant's argument that Piazza lacks both the first golf ball marker holding portion for storing a golf ball marker and the second golf ball marker holding portion for depositing a golf ball marker on and retrieving a golf ball marker from the ground. Thus, even if the handle of Piazza's tool were modified to hold a golf ball marker as suggested and taught by Erickson (i.e., the claimed first golf ball marker holding portion for storing a golf ball

marker) the modified tool of Piazza would still lack the second golf ball marker holding portion for depositing a golf ball marker on and retrieving a golf ball marker from the ground. In that regard, it is our view that the examiner's determination (answer, p. 4) that Piazza's "pump is obviously capable of storing and retrieving a golf ball marker" lacks sufficient evidentiary and technical basis. Accordingly, it is our determination that Piazza's pump is not inherently capable of storing and retrieving a golf ball marker. As such, the above-noted modification of Piazza does not arrive at the subject matter of claim 7.

For the reasons set forth above, the decision of the examiner to reject claim 7, and claims 2, 11, 21 and 22 dependent thereon, under 35 U.S.C. § 103 is reversed.

#### **Claims 8 to 10**

We will not sustain the rejection of claims 8 to 10 under 35 U.S.C. § 103 as being unpatentable over Piazza in view of Erickson and Pruitt.

We have also reviewed the reference to Pruitt additionally applied in the rejection of dependent claims 8 to 10 but find nothing therein which makes up for the deficiencies of Piazza and Erickson discussed above with respect to parent claim 7.

Accordingly, the decision of the examiner to reject claims 8 to 10 under 35 U.S.C. § 103 is reversed.

### **Claims 13 to 15**

We will not sustain the rejection of claims 13 to 15 under 35 U.S.C. § 103 as being unpatentable over Piazza in view of Luther.

We agree with the examiner's determination (answer, p. 5) that it would have been obvious to one of ordinary skill in the art to add the support legs of Luther to Piazza's tool in order to support the tool when not in use.<sup>2</sup> However, we do not agree with the examiner's subsequent determination (answer, p. 5) that it would have been further obvious to one of ordinary skill in the art to have replaced the non-pivoting legs of Luther with legs that are hingedly attached (i.e., pivotally mounted) in view of the fact that hinges are well known in the art of supports.<sup>3</sup> In our view, the only suggestion for modifying the non-pivoting legs suggested and taught by Luther in the manner proposed by the examiner to arrive at the subject matter of claim 13 stems from

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<sup>2</sup> It appears to us that Luther is closer prior art to the subject matter of claim 13 than Piazza since Luther teaches a golfing aid having (1) an elongated member having a first end and a second end, the first end being provided with golf ball holding means, and the elongated member further being provided with means for releasing a golf ball from the holding means; and (2) legs mounted on the elongated member for supporting the elongated member.

<sup>3</sup> The examiner may wish to conduct a further search of the prior art to uncover prior art teaching the use of support legs pivoted to a golfing device (e.g., a golf bag).

hindsight knowledge derived from the appellant's own disclosure, not the teachings of the applied prior art. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claim 13, and claims 14 and 15 dependent thereon, under 35 U.S.C. § 103 is reversed.



CONCLUSION

To summarize, the decision of the examiner to reject claims 2 to 11, 13 to 15, 21 and 22 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT  
Administrative Patent Judge

LAWRENCE J. STAAB  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

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